

### **Remarks**

Claims 19-29 and 31 are canceled herein. (The amendment of December 17, 2007 was not entered by the examiner; therefore, claims 37-40 set forth in that amendment were not entered.) Claim 30 is amended herein to incorporate the limitations of claim 31. The current amendments are provided to place the application in condition for allowance and, in the alternative, to simplify the issues for appeal.

Claim 30, as amended, requires the storage be designed as a rigid receptacle.

Applicant notes that the amendment submitted herein does not raise any new issues because the amendment simply incorporates into claim 30 a limitation previously provided in dependent claim 31, herein canceled. Accordingly, claim 30 is now equivalent to claim 31 in an independent format.

Claim 30 is not anticipated by USPN 4315509 to Smit at least because Smit does not disclose a storage that is designed as a rigid receptacle.

Claim 30 is also not anticipated by USPN 5246456 to Wilkinson because Wilkinson also does not disclose a storage that is designed as a rigid receptacle.

As discussed below, both Smit and Wilkinson expressly provide disclosures that teach away from making either of the disclosed devices rigid. Furthermore, making either of these devices rigid would render them unsatisfactory for their intended purposes and would change their principle of operation.

Accordingly, it would not be obvious to combine either reference with USPN 4315509 to Crabb. Therefore, claim 30 is patentable over Smit in view of Crabb as well as Wilkinson in view of Crabb.

### **Smit**

Smit provides at least two reasons that the tubular implant disclosed would not be rigid. The two reasons Smit provides include the prevention of the small intestine gathering on the implant and maintaining an implant that expands and contracts to maintain normal intestinal reactions to food.

Smit specifically discloses that “because the walls of the tube (the extremely thin-walled tube 32) lack rigid support, the small intestine does not tend to gather itself and bunch

up along the tube, as often happens on catheters with thicker and more rigid tubes” (col. 5 lines 7-10). Smit continues on to expressly state that “it is not uncommon for the entire small intestine to gather itself along perhaps a three-foot section of fairly stiff tubing and then to pass any remaining tubing out the anus” (col. 5 lines 10-14). Smit concludes by indicating that “since tube 32 is balloon-thin and very supple, it does not support the small intestine and, therefore, prevents gathering of the intestine” (col. 5 lines 14-16).

Smit also discloses that “the tubular implant retains a very narrow or collapsed diameter when empty of food chemicals and expands outwardly as food chemicals enter” (col. 1 lines 26-29). Smit continues on to recite that “thus when the intestinal walls feel a change in diameter, they commence peristaltic movements and contractions which squeeze the liquefied chyme through the tubular implant and then out its open end” (col. 1 lines 29-32). Through this express disclosure Smit teaches the implant as a device that through its flexibility allows “normal peristaltic movements and contractions, in the patient’s body” (col. 1 lines 24-26). As further acknowledged by the Examiner in the Advisory Action of January 22, 2008, “the Smit device is disclosed to be flexible” (see Advisory Action Continuation Sheet).

In view of Smit’s disclosure that the implant provided therein lacks rigid support to prevent gathering and further in view of Smit’s disclosure that the flexibility of the implant disclosed allows it to function consistent with normal body functions, it would not have been obvious for one of ordinary skill in the art to modify the device disclosed in Smit to be rigid, even in view of Crabb.

Accordingly, claim 30 is patentable over Smit in view of Crabb for at least the aforementioned reasons.

### **Wilkinson**

Because Wilkinson expressly provides that the pouch disclosed therein is made of an elastomer having a durometer of 30, Wilkinson indicating that the elastomer used is the same material used for medical grade silicone rubber and tissue expanders, and because Wilkinson further characterizes the pouch as a hollow, **flexible** and thin-walled gastric pouch, it would not have been obvious to make the disclosed pouch rigid.

Specifically, Wilkinson provides that “the pouch 10 is constructed of medical grade, high performance silicon elastomer, 30 durometer” (col. 3 lines 39-40). Elastomers are generally a type of polymer having an elastic property. Wilkinson specifically recites that the elastomer used in the manufacture of the device disclosed therein has a durometer of 30, indicating that it is not hard or rigid.

Wilkinson goes on to expressly indicate that the disclosed pouch is flexible through his characterization of the device as “a hollow, **flexible** and thin-walled gastric pouch” (col. 5 line 48, claim 1).

Further, because the device of Wilkinson is in fact a stomach pouch that has to be secured around the patient’s stomach and the pouch only includes a slot 28 for applying the pouch around a patient’s stomach, it requires a degree of flexibility by design that would not be included if the device was rigid. Thus, making Wilkinson rigid would require a change in the basic principle under which the construction was designed to operate, rendering the modification non-obvious (MPEP 2143.01, VI).

Furthermore, while the Examiner asserts that the region referred to as a collar in Wilkinson may be interpreted as a tube region, Applicant directs the Examiner’s attention to Fig. 3 of Wilkinson where an enlarged view of collar 30 is illustrated. As illustrated in Fig. 3 collar 30 is clearly distinguishable from a tube. Wilkinson’s specification describes collar 30 as a “radially split annular collar 30” and Fig. 2 further demonstrates slit 32 of collar 30.” Accordingly, Wilkinson does not have two tubes as required in claim 30 and all the claims depending therefrom.

In view of the express disclosures provided by Wilkinson, it would not have been obvious to one of ordinary skill in the art to modify the device disclosed in Wilkinson to be rigid, even in view of Crabb. Additionally, because Wilkinson fails to disclose all of the claimed limitations and Crabb fails to disclose the claim limitations not taught or suggested by Wilkinson, the claimed invention is not obvious in view of Wilkinson and Crabb.

Accordingly, claim 30 is patentable over Wilkinson in view of Crabb for at least the aforementioned reasons.

Claim 32 depends from claim 30 and is patentable over Smit and Wilkinson alone or in combination with Crabb for at least the same reasons that claim 30 is patentable over both Smit and Wilkinson alone or in combination with Crabb.

For the reasons set forth above, it is submitted that all pending claims are allowable over the art of record. Reconsideration of the claims and a notice of allowance are therefore respectfully requested.

Applicant's undersigned representative requests that the Examiner contact him at (617) 443-9292 to expedite the resolution of any remaining questions or concerns, particularly regarding entry of the requested amendment.

Respectfully submitted,

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